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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,566	05/07/2001	Anton Negele	205892USOPCT	1079
22850	7590	04/08/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			REDDICK, MARIE L.	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/830,566	<b>Applicant(s)</b> NEGELE ET AL.	
	<b>Examiner</b> Judy M. Reddick	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Response to Amendment**

1. The amendment, coupled with Counsel's persuasive arguments, filed on 12/31/03 is sufficient to remove the Claim and Specification Objections, the rejection under 35 USC 112, 1<sup>st</sup> paragraph, the claim rejection under 35 USC 102(e)/103(a) and the claim rejection under 35 USC 103(a) as set forth in the previous Office Action (paper no. 17, 10/01/03). However, New Prior Art has come to the Examiner's attention and a rejection based on such is set forth infra.

**Information Disclosure Statement**

2. The information disclosure statement filed 07/12/01, although considered and placed in the application file, has been misplaced (the initialed copy). Applicant is kindly requested to submit, along with the response to this Office Action, a copy of the initialed FORM PTO 1449 (attached to the Office Action of 09/12/02). An apology is extended to applicant for any inconvenience that this may have caused.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al (U.S. 5,962,570).

Sato et al disclose and exemplify a process for the preparation of an aqueous solution or dispersion containing a water-soluble cationic polymer, useful as a flocculant or paper chemical, wherein said process, basically, involves the steps of: polymerizing a monomer including an N-vinylcarboxylic acid amide represented by the general formula  $\text{CH}_2=\text{CHNHCOR}$ , wherein R represents a hydrogen atom or methyl group such as N-vinylformamide and/or N-vinylacetamide, alone or further in combination with other vinyl monomers such as acrylonitrile, acrylamide, etc. in an aqueous medium in the presence of either or both of a polyethylene glycol and polypropylene glycol, in an amount of 1 to 150 wt.%, based on the total monomer weight, and then modifying (hydrolyzing) the resulting polymer with an acid or base.

Specifically, an aqueous composition containing a cationic polymer, which comprises (A) a modified N-vinylcarboxylic acid amide polymer, (B) either or both of a polyethylene glycol and polypropylene glycol, and (C) water is disclosed (See the Abstract). Sato et al @ col. 5, lines 9-17, teaches that in order to enhance the precipitability of the polymer, various inorganic salts may be used together with the other antecedently recited components. Sato et al, more specifically @ col. 6, lines 43-67 teaches that the reaction solution (aqueous solution or dispersion) comprising the water-soluble cationic polymer comprises, as main components, three components: (A) a modified N-vinylcarboxylic acid amide polymer, (B) a polyethylene glycol or the like and (C) water wherein, the contents of the modified N-vinylcarboxylic acid amide polymer (A), the polyethylene glycol or the like (B) and water (C) are from 5 to 45% by weight, from 0.05 to 60% by weight, and from 5 to 94.95% by weight, respectively, based on the total weight of the three components (A), (B) and (C). More specifically, Sato et al exemplify processes for preparing aqueous fine dispersions of various N-vinylformamide-containing

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polymers prepared in the presence of polyethylene glycol and hydrolyzed products therefrom which, according to the Examiners calculations, contain a negligible amount of salt, if any at all(sufficient to meet the claimed limitation "substantially free of stabilizing inorganic salt"). See at least Runs 5-7, 9 & 10. Sato et al therefore anticipate the instantly claimed invention with the understanding that the N-vinylcarboxylic acid amide-containing aqueous fine dispersions and modified products(hydrolyzed) therefrom of Sato et al overlap in scope with the instantly claimed invention. It would be expected that the particle size, as claimed, would be met by Sato et al since the N-vinylcarboxylic acid amide-containing water-soluble polymer of Sato et al is essentially the same as and made under essentially the same conditions as the claimed N-vinylformamide and/or N-vinylacetamide-containing water-soluble polymer. The onus to show that, in fact, this is not the case, is shifted to applicants. It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433(CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

#### Conclusion

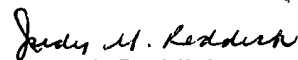
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
04/05/04